

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-6 and 8-10 are rejected under 35 USC 103(a) over the U.S. patent to Treace in view of one of the U.S. patents to Paulus, Johnson and Wurst patent publication.

After carefully considering the Examiners grounds for rejection of the claims over the art, applicant retained Claim 1, the broadest claim on file as it was, and amended Claim 5 by introducing into it the features of Claims 1 and 4 and thus making it independent.

It is respectfully submitted that Claims 1 and 5 clearly and patentably distinguish the present invention from the prior art applied against the original claims.

Claim 1 specifically defines that in the inventive tool unit with a working edge having a first lateral boundary line, the first lateral boundary line is a straight line which extends from the working edge in a first radial direction with respect to the center of the fastening means.

Claim 5 additionally defines that the second lateral boundary line is also a straight edge which extends from the working edge in a second radial direction with respect to the center.

The claims refer to the boundary lines which are formed as straight edges extending in corresponding radial directions. This means that the boundary line is a straight radial line which extends from the periphery or from the working edge and in a radial (along a radius) towards the center of the fastening means.

Turning now to the references applied by the Examiner, and in particular to the patent to Treace, it can be seen that this reference discloses a surgical saw blade having first and second boundary edges at opposite ends of the working edge. In contrast to the present invention as defined in Claims 1 and 6, none of the boundary edges is straight and none of the boundary edges extends in a radial direction, or in other words over a radius from the working edge towards the center.

Thus, this reference does not teach the new features of the present invention as defined in Claims 1 and 5.

The patent to Paulus discloses a cutting device with rotating cutters. The cutting device has two opposite working edges. Contrary to the applicant's invention, while the lateral boundary lines at the ends of each of the working edges are straight lines, they are not radial straight lines or in other words they do not extend from the working edge exactly in the radial direction or along a radius which intersects with the center.

This reference also does not teach the new features of the present invention as defined in Claims 1 and 5.

In the blade for a vibrating cutter disclosed in the patent to Johnson, the boundary lines are formed as straight lines, but they do not extend as radii through the center and therefore they do not extend in radial directions.

In the patent to Wurst, some boundary lines are curved and do not extend through the center and therefore not in the radial direction, while in the embodiment shown in Figures 3-7 the boundary lines are straight and do not extend in a radial direction as well.

It can be seen that therefore none of the references discloses the new features of the present invention as defined in Claims 1 and 5.

The above-emphasized new features of the present invention provide for the highly advantageous results which cannot be accomplished by the constructions disclosed in the references. In particular when the boundary lines in which the working edges transitions are formed as straight radial lines, then during the operation in which cutting is performed in the area close to the edge, the corners of the working edge are supported in an optimal manner. This provides for a significant advantage during the cutting operations, and these results cannot be achieved by the constructions disclosed in the references.

The Examiner rejected the claims over the combinations of the references.

First of all, it is respectfully submitted that it cannot be considered as obvious to combine the references. The primary reference, namely the patent to Treace discloses curved boundary edges which are not straight and not radial (do not extend in a radial directions), while the patent to Paulus discloses two working edges, and boundary lines which are straight and non-radial. A person of ordinary skill in the art would not combine curved boundary edges of the Treace reference with the straight boundary edges of the Paulus reference.

The combination of the patent to Treace with the Johnson reference also cannot be considered as obvious, since the curved, non-radial

boundary edges of the Treace reference are not combinable with straight, non-radial boundary edges of the Johnson reference.

The same is true for the combination of the Treace and Wurst references. If the curved boundary edges of the Treace and Wurst reference are combined with one another, they will not be formed as straight lines extending in the radial direction. The curved boundary edges of the Treace reference cannot be combined with the straight boundary edges of another embodiment of the invention disclosed in the Wurst reference.

As explained hereinabove, the present invention provides for the highly advantageous results. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

Also, the references do not contain any hint, suggestion or motivation for combining them with one another.

It is therefore believed that the Examiner's rejection of original claims over the combination of the patent to Treace with one of the Paulus, Johnson and Wurst references would not lead to the applicant's invention as defined in Claims 1 and 5. In order to arrive at the applicant's invention from the teachings of the references, the references should be first combined for some unknown and highly unusual reasons, and then they should be modified by the new features of the present invention which are now defined in Claims 1 and 5 and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Claims 1 and 5 should be considered as patentably distinguishing over the art and should be allowed.

As for the other dependent claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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